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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,784	06/19/2000	James Crawford	06975-097001	4992

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EXAMINER
SHINGLES, KRISTIE D

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/597,784	CRAWFORD, JAMES
	Examiner	Art Unit	
	Kristie Shingles	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _03 October 2005_.

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-40 and 45-70_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-40 and 45-70_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Per Applicant's Request for Continued Examination:

Claim 61 has been amended. Claims 41-44 have been cancelled.
Claims 65-70 are new.

Claims 1-40 and 45-70 are pending.

Continued Examination Under 37 CFR 1.114 .

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114.   Applicant's submission filed on

10/3/2005 has been entered.

Response to Arguments

2.   Applicant's arguments with respect to claims 1 have been considered but are moot

in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   <u>Claims 1-40 and 45-70</u> are rejected under 35 U.S.C. 103(a) as being unpatentable

over *Donovan* (US 2004/0193722) in view of *van Hoff et al* (US 5,761,421).

      a.   **Per claims 1, 29, and 31**, *Donovan* teaches a method, apparatus, and

computer program, stored on a computer readable medium for transferring a file from a

first client associated with a first subscriber to a communications system to a second

client associated with a second subscriber to the communications system, the method

comprising:

- connecting the first client to a communications system host (paragraphs 0019-0025);

- sending, through the communications system host, a request to the second client to establish a direct connection to the second client (paragraph 0034);

- if a user of the second client accepts the request, establishing a direct connection to the second client that bypasses the communications system host (paragraphs 0034-0036; user of the second client accepts the request and a direct connection is subsequently established between the first and second client); and

- transferring a file over the direct connection (paragraph 0037).

      Although *Donovan* does teach a first client sending a connection request

to the second client via the instant messaging system (paragraph 0034); *Donovan* fails to

explicitly state that the request is to establish direct connection to the second client.

However, *van Hoff et al* teach a first computer requesting peer-to-peer communication

connection with the second client, wherein the second client is able to accept or reject the

request (col.1 lines 55-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Donovan* with *van Hoff et al* for the purpose of allowing clients to specifically request peer-to-peer or direct connections with other clients. Peer-to-peer connections cause the client devices to be more vulnerable without an intermediary host or server to relay the transmitted data, therefore it would be obvious to allow users to determine and discern between whom has direct connectivity with their devices.

b.   **Per claims 14, 30, and 36,** *Donovan* teaches a method, apparatus, and a computer program, stored on a computer readable medium for transferring a file from a first client associated with a first subscriber to a communications system to a second client associated with a second subscriber to the communications system, the method comprising:

- connecting the second client to a communications system host (paragraphs 0019-0025);

- receiving, through the communications system host, a request from the first client to establish a direct connection (paragraph 0034);

- enable a user to accept the request from the first client (paragraphs 0034-0036; user of the second client accepts the request and a direct connection is subsequently established between the first and second client);

- establishing a direct connection to the first client that bypasses the communications system host (paragraphs 0036, 0037); and

- receiving a file over the direct connection (paragraph 0037).

Although *Donovan* does teach a first client sending a connection request to the second client via the instant messaging system (paragraph 0034); *Donovan* fails to explicitly state that the request is to establish direct connection to the second client.

However, *van Hoff et al* teach a first computer requesting peer-to-peer communication connection with the second client, wherein the second client is able to accept or reject the request (col.1 lines 55-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Donovan* with *van Hoff et al* for the purpose of allowing clients to specifically request peer-to-peer or direct connections with other clients. Peer-to-peer connections cause the client devices to be more vulnerable without an intermediary host or server to relay the transmitted data, therefore it would be obvious to allow users to determine and discern between whom has direct connectivity with their devices.

c.   **Per claim 45,** *Donovan* teaches a user interface configured to enable to acceptance or rejection of a file transfer from a first client associated with a first subscriber to a communications system to a second client associated with a second subscriber to the communications system, the user interface comprising:

- a first graphical user interface element structured and arranged to notify an operator of the second client of a request by the first client to establish a direct connection to the second client, the request being communicated to the second client by a communications system host and the direct connection bypassing the communications system host (paragraphs 0034-0036); and
- a second graphical user interface element structured and arranged to enable an operator of the second client to authorize the establishment of the direct connection and a file transfer over the direct connection (paragraphs 0034-0037).

Although *Donovan* does teach a first client sending a connection request to the second client via the instant messaging system (paragraph 0034); *Donovan* fails to explicitly state that the request is to establish direct connection to the second client.

However, *van Hoff et al* teach a first computer requesting peer-to-peer communication connection with the second computer, wherein the second computer is able to accept or reject the request (col.1 lines 55-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Donovan* with *van Hoff et al* for the purpose of allowing clients to specifically request peer-to-peer or direct connections with other clients. Peer-to-peer connections cause the client devices to be more vulnerable without an intermediary host or server to relay the transmitted data, therefore it would be obvious to allow users to determine and discern between whom has direct connectivity with their devices.

d.   **Per claim 2**, *Donovan* and *van Hoff et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the request is authenticated by the communications system host (paragraphs 0033, 0038, 0039).

e.   **Per claims 3 and 16**, *Donovan* and *van Hoff et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the second client accepts the request based on indicated preferences of the second subscriber (paragraph 0035).

f.   **Per claims 4 and 17**, *Donovan* and *van Hoff et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the direct connection is initiated by the second client (paragraphs 0034-0036).

g.   **Per claims 5 and 18**, *Donovan* and *van Hoff et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the direct connection to the second client is established using an IP address of the second client (paragraphs 0020, 0034).

h.   **Per claims 6 and 19**, *Donovan* and *van Hoff et al* teach the method of claim 1 and 14, *Donovan* further teaches further comprising displaying a graphical user interface indicating that a direct connection to the second client is established (paragraphs 0034, 0037).

i.   **Per claims 7 and 20**, *Donovan* and *van Hoff et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the communications system host comprises an instant messaging host (paragraphs 0009, 0026, 0027, 0033, 0036).

j.   **Per claims 8 and 21**, *Donovan* and *van Hoff et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the file comprises a data file (paragraphs 0019, 0037).

k.   **Per claims 9 and 22**, *Donovan* and *van Hoff et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the file comprises a text file (paragraphs 0019,0037).

l.   **Per claims 10 and 23**, *Donovan* and *van Hoff et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the file comprises a graphics file (paragraph 0037).

m.   **Per claims 11 and 24**, *Donovan* and *van Hoff et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the file comprises an audio file (paragraphs 0019, 0037).

n.   **Per claims 12 and 25**, *Donovan* and *van Hoff et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the file comprises a video file (paragraph 0037).

o.   **Per claims 13 and 28,** *Donovan* and *van Hoff et al* teach the method of claim 1 and 14, *van Hoff et al* further teach wherein the direct connection is a socket connection (col.2 lines 49-65; *Donovan*: paragraphs 0036, 0037).

p.   **Per claim 26,** *Donovan* and *van Hoff et al* teach the method of claim 14, *Donovan* further teaches the method further comprising receiving an indication that the first subscriber using the first client is composing a message (paragraphs 0041-0044).

q.   **Per claim 27,** *Donovan* and *van Hoff et al* teach the method of claim 26, *Donovan* further teaches the method further comprising receiving the message composed by the first subscriber from the first client (paragraphs 0041-0044).

r.   **Per claims 32 and 37,** *Donovan* and *van Hoff et al* teach the method of claim 31 and 36, *Donovan* further teaches wherein the computer readable medium comprises a disc (paragraphs 0009, 0018).

s.   **Per claims 33 and 38,** *Donovan* and *van Hoff et al* teach the method of claim 31 and 36, *Donovan* further teaches wherein the computer readable medium comprises a client device (paragraphs 0009, 0018).

t.   **Per claims 34 and 39,** *Donovan* and *van Hoff et al* teach the method of claim 31 and 36, *Donovan* further teaches wherein the computer readable medium comprises a host device (paragraphs 0036, 0037).

u.   **Per claims 35 and 40,** *Donovan* and *van Hoff et al* teach the method of claim 31 and 36, *Donovan* further teaches wherein the computer readable medium comprises a propagated signal (paragraphs 0009, 0018, 0019).

v.   **Per claim 46**, *Donovan* and *van Hoff et al* teach the user interface of claim 45, *Donovan* further teaches wherein the first graphical user interface element is a dialog box (paragraph 0034).

w.   **Per claim 47**, *Donovan* and *van Hoff et al* teach the user interface of claim 45, *Donovan* further teaches wherein the second graphical user interface element includes a set of sub elements selectable by the recipient to authorize or reject establishment of the direct connection (paragraphs 0034, 0035).

x.   **Per claim 48**, *Donovan* teaches the user interface of claim 47 wherein the sub elements are option buttons (paragraph 0034).

y.   **Per claim 49**, *Donovan* teaches the user interface of claim 47 wherein the sub elements include a sub element selectable to authorize the direct connection (paragraphs 0034, 0035).

z.   **Per claim 50**, *Donovan* teaches the user interface of claim 47 wherein the sub elements include a sub element selectable to reject the direct connection (paragraph 0034).

aa.   **Per claim 51**, *Donovan* and *van Hoff et al* teach the user interface of claim 47, *van Hoff et al* further teach wherein the sub elements include a sub element selectable to ignore the request (col.4 lines 18-21).

bb.   **Per claim 52**, *Donovan* and *van Hoff et al* teach the user interface of claim 47 wherein the sub elements include a sub element selectable to warn the first client not to send future requests for a direct connection to the second client (col.4 lines 18-21).

cc.   **Per claims 53, 55, and 57**, *Donovan* and *van Hoff et al* teach the method of claim 1, 29, and 31, *Donovan* further teaches wherein connecting the first client to a

communication system host includes connecting from the first client to the communication system host (paragraphs 0019-0025).

dd.   **Per claims 54, 56, and 58,** *Donovan* and *van Hoff et al* teach the method of claim 14, 30, and 36, *Donovan* further teaches wherein connecting the second client to a communications system host includes connecting from the second client to the communications system host (paragraphs 0019-0025).

ee.   **Per claims 59-64,** *Donovan* and *van Hoff et al* teach the method of claim 1, 14, 29, 30, 31, and 36, *Donovan* further teaches the method further comprising enabling the user to perceive the request and monitoring a response by the user to the request (paragraphs 0034, 0035).

ff.   **Per claims 65-70,** *Donovan* and *van Hoff et al* teach the method of claims 59-64, *Donovan* further teaches the method further comprising enabling the request to be visually presented in a graphical user interface to the user of the second client (paragraphs 0034, 0035).

Conclusion

5.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Ozzie (US 6,640,241), Sun et al (US 6,704,282), Kleinpeter III et al (US 6,907,463), Szlam (US 6,359,892), Bendinelli et al (US 6,631,416).

6.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

kds

RUPAL DHARIA